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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT		ATTORNEY DOCKET NO.
09/[illegible]	01	CHOW	K	1724 MAP

HM12/0925

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EXAMINER	
HIGEL,F	

ART UNIT	PAPER NUMBER
1626	5

09/25/01
DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 TO 106 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1 TO 106 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

PTOL-326 (Rev. 7-96)

* U.S. GPO: 1998-404-436/40517

Receipt is acknowledged of the information disclosure statement filed July 2, 2001, which has been entered in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Insertion at an appropriate place therein of the current stats of the parent application mentioned on page 1 of the specification is required.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 88 to 194 are rejected under 35 USC 112, second paragraph, for failing to properly define the invention. Since actual Markush language is not employed the expression "and all pharmacologically acceptable... and racemic mixtures" must be changed to or all pharmacologically acceptable... or racemic mixtures. The terms and expressions "esters",

condense to form", "optional double bonds", "selective agonist activity... adrenergic receptor sub type (s) ... receptor subtype", "condense together to form" and, "may share" render the claims indefinite by placing no definite limits or boundaries on the claims so that one of ordinary skill in the art does not know exactly what is being claimed.

Claims 1 to 45 and 47 to 57 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kihara et al (Japanese Pat. No. 1/242571), cited by applicants.

Please note page 2 and the compounds in the Table on pages 5 and 6 and also the last compound on page 4.

Claims 1 to 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kihara et al (Japanese Pat. No 1/24257/ or Tokyo (WO 94-07866) or Orion (WO 97-12874) or Boyd et al I or II or Zhang et al, al cited by applicants.

The references disclose compounds which are homologs, isomers or structural analogs of the claimed compounds and having a viable utility. The claimed compounds are so closely related structurally to the claimed compounds as to be structurally obvious therefrom in the absence of any unobvious or unexpected properties especially since one of ordinary skill in the art would expect that compounds so closely related would have the same or essentially the same properties see, for example, the Abstract of Tokyo; pages 13 to 15 and the claims of Orion; the Examples of and claims of Boyd et al. I and II; and page 30 14, compounds 1, 2a, and 2b of Zhang et al. No showing of any unobvious or unexpected properties has been forthcoming, i.e. it has not been shown that the prior art compounds do not possess the recited activity or that the claimed

compound have the recited agonist activity to an unobvious or unexpected degrees as compared to the prior art compounds.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 to 106 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim the claims of copending Application No. 09/679,919. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

No claims are allowed.

Any inquiry concerning this communication should be directed to Floyd D. Higel at telephone number (703) -308-4530.

Higel/LR

September 20, 2001

FLOYD D. HIGEL
PATENT PRIMARY EXAMINER
ART UNIT ~~123~~ 1626